

REMARKS

Upon entry of the present amendment, claims 18, 20, 21, 24-26, 30, 31, 33-35, 37-47 and 53 are pending in the above-referenced patent application and are currently under examination. Claims 18, 24, 41, 43, 45, 47 and 53 have been amended. Claim 1-17, 19, 22, 23, 27-29, 32, 36 and 48-52 have been canceled. Reconsideration of the application is respectfully requested.

Claim 1 has been amended to recite the limitations of canceled claims 19 and 23, as well as to limit the scope of radicals R¹ and Y. Additional amendments have been made to correct spelling errors. Support for the amendments to the claim can be found in original claims 18, 19 and 23, as well as throughout the specification.

Claim 24 has been amended to correct claim dependency in view of canceled claim 23.

Claims 41, 43, 45 and 47 have been amended to conform to the scope of amended claim 18. Support for these amendments finds support in the original claims and throughout the specification.

Claim 53 has been amended to correct claim dependency in view of canceled claim 1.

Applicants believe the claim amendments add no new matter to the claims.

I. ANTICIPATION REJECTION OVER PENNELL

Claims 1, 4, 6, 7, 10, 11, 18-21, 23-27, 30-35, 37-43, 46, 47 and 53 have been rejected under 35 USC § 102(e) as allegedly being anticipated in view of Pennell. Applicants respectfully traverse the rejections in view of the comments below.

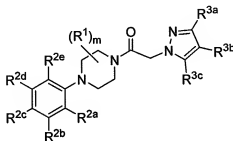
A claim is considered to be anticipated under 35 USC § 102(e), when filed after November 29, 2000, if

the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

In order for a claim to be anticipated by a single reference, the reference must teach every element of the claim (MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). As discussed in detail below, the presently claimed invention is

not anticipated in view of the cited reference as the reference fails to teach every element set forth in the claims of the instant invention.

In an effort to reduce the outstanding issues, the instant claims have been amended to the scope of claims 18, 19 and 23, while limiting radicals R^1 and Y. Accordingly, the compounds of the present invention are those of the following formula:



having the following limitations:

1. R^1 is a C_{1-4} alkyl group when present
2. At least one of R^{3a} , R^{3b} and R^{3c} is a Y group where Y is "furanyl, pyridyl, pyrimidinyl, pyrazinyl, pyridizynyl, pyrazolyl, imidazolyl, thiazolyl, oxazolyl, isoxazolyl, isothiazolyl, triazolyl, tetrazolyl and oxadiazolyl" but not phenyl or thienyl.
3. At least one of R^{3a} , R^{3b} and R^{3c} is a halogen, C_{1-4} alkyl or C_{1-4} haloalkyl.

Accordingly, the pyrazole ring of the instant application must be substituted with a heteroaryl Y group that does not include phenyl or thienyl, as well as a halogen, C_{1-4} alkyl or C_{1-4} haloalkyl.

Applicants respectfully submit that the compounds of Pennell do not meet the limitations of the instantly amended claims, because the compounds of Pennell do not describe a compound where the pyrazole ring (HAr of Pennell) is substituted with (1) a heteroaryl Y group that does not include phenyl or thienyl, and (2) a halogen, C_{1-4} alkyl or C_{1-4} haloalkyl. Because the compounds of Pennell fail to describe all the limitations of the instantly amended claims, Applicants submit that the instantly amended claims are not anticipated under 35 U.S.C. § 102(e) by Pennell. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

II. OBVIOUSNESS REJECTION OVER PENNELL

Claims 44 and 45 have been rejected under 35 USC § 103(a) as allegedly being obvious over Pennell. Applicants respectfully traverse the rejection in view of the comments below.

Applicants submit that under 35 U.S.C. § 103(c), claims 44 and 45, and the remaining instantly amended claims, are not obvious over Pennell. 35 U.S.C. § 103(c)(1) provides that the claimed invention is not obvious under § 103(a) if (1) the prior art reference qualifies as prior art only under one

or more of § 102(e), (f), and (g), and (2) the prior art reference is by another person where the subject matter of the prior art reference and the claimed invention are subject to an obligation of assignment to the same person.

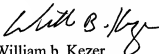
As noted above, Pennell is prior art to the instant application under only 35 U.S.C. § 102(e), and thus meets the first requirement under § 103(c)(1). Moreover, as the Examiner concedes on page 3 of the Office Action, the instant application and Pennell are commonly assigned to ChemoCentryx. Thus, the second requirement of an obligation to assign to the same person under § 103(c)(1) is met. As both requirements under § 103(c)(1) are met, Applicants respectively submit that the amended claims of the instant application are not obvious under 35 U.S.C. § 103(a) over Pennell. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


William b. Kezer
Reg. No. 37,369

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
ART:art
61861163 v1